

REMARKS

Claims 36-44 are pending. By this Amendment, no claims are cancelled, claims 36 and 44 are amended, and no new claims are added.

Claim Rejections Under 35 USC 112

Claims 36-44 were rejected as allegedly lacking written description support for “determination if said desired objective corresponds to a magnification of one of said one or more previously-captured images; and wherein if said desired objective corresponds to a magnification of one of said one or more previously-captured images, displaying said one of said one or more previously-captured images on a screen, and wherein if said desired objective does not correspond to a magnification of one of said one or more previously-captured images, obtaining a real-time image of microscope slide at said desired magnification and presenting said real-time image on said screen.” Applicant respectfully traverses this rejection. Those of ordinary skill in the art would readily recognize that the present inventors had possession of the claimed invention based on the disclosure found, inter alia, at paragraphs 0011-0014 of the specification and in Figure 2 of the present application.

Nevertheless, solely to advance prosecution and without acquiescence in the contentions of the Office regarding lack of written description, Applicant has amended base claims 36 and 44 to obviate this rejection. The claims as amended now recite presenting a user with a plurality of objectives for viewing the slide at different magnifications. At least one of the objectives corresponds to a previously captured image of the slide at least another corresponds to a real time image of the slide. Based on the user’s selection of an objective, the corresponding previously

captured image or real time image is presented on a screen. Applicant respectfully submits that these limitations are supported in the instant specification at least at paragraphs 0011-0014 and in Figure 2. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claims 37-43 were further rejected as lacking antecedent basis for “said previously captured image.” Applicant respectfully submits that this rejection has been obviated by amendments to base claim 36. Accordingly, Applicant requests that this rejection be withdrawn.

Claim Rejections Under 35 USC 102

Claims 36, 37 and 44 were rejected as anticipated by Kamentsky ‘969. Applicant respectfully traverses this rejection. The passages of Kamentsky ‘969 cited by the Examiner describe an initial process of capturing real time images, annotating and storing those images (col. 8, last paragraph), and a later process of retrieving and viewing the stored images (col. 9, second paragraph). There is no disclosure or suggestion in these passages of Kamentsky ‘969 of enabling a user to view either a stored image corresponding to a desired magnification, or if no such image is stored, a real time image at the desired magnification, as in the claimed invention. Since Kamentsky ‘969 does not disclose or suggest all limitations of the claimed invention, it cannot anticipate or render the claimed invention obvious.

Nevertheless, solely to advance prosecution and without any waiver or disclaimer of subject matter, Applicant has amended base claims 36 and 44 to further clarify the claimed invention. Regarding claim 36, these amendments clarify that the user is presented with a plurality of objectives for viewing the microscope slide, the plurality of objectives including at least a first objective corresponding to the at least one previously captured image and at least a

second objective corresponding to a real-time image of the microscope slide at a magnification different from the magnification of the at least one previously captured image. If the first objective is selected, the corresponding previously-captured image is displayed on a screen, and if the second objective is selected, the corresponding real-time image is presented on the screen. The Kamentsky '969 device does not disclose or suggest at least these limitations.

Claim 44 has been amended to recite selecting a desired objective for viewing a microscope slide, the desired objective corresponding to a desired magnification. If the desired objective corresponds to one of the one or more previously-captured images, the images are on a screen, and if the desired objective does not correspond to one of said one or more previously-captured images, a real-time image of the microscope slide at the desired magnification is obtained and presented on the screen. The Kamentsky '969 device does not disclose or suggest at least these limitations.

Based on the foregoing, Applicant respectfully submits that Kamentsky '969 does not anticipate or render the invention of claims 36, 37, and 44 obvious. As a result, Applicant requests that this rejection be withdrawn.

Claim Rejections Under 35 USC 103

Claims 36-44 were rejected as obvious over Kamentsky '969 in view of Silverbrook '616. Applicant respectfully submits, as set forth above, that Kamentsky '969 does not disclose or suggest all limitations of base claims 36 and 44. Further, Silverbrook '616 does nothing to remedy the deficiencies of Kamentsky '969. Consequently, the combination of Kamentsky '969 and Silverbrook '616 cannot render the invention of claims 36 and 44, nor that of any claim

dependent therefrom, obvious. As a result, Applicant respectfully requests that this rejection be withdrawn.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'B. Thorson', with a stylized, flowing script.

Bradley J. Thorson
Registration No. 52,288

Customer No. 24113
Patterson, Thunte, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 349-5740